

## **REMARKS**

It is respectfully requested that this application be reconsidered in view of the following remarks and that all of the claims currently under examination be allowed.

### **Restriction Requirement**

The first page of the Office Action erroneously states that Claims 1-16 are pending in this application. However, for the record, Applicants note that Claims 1-23 are pending with Claims 17-23 having been withdrawn from consideration due to the restriction requirement of October 30, 2006. Applicants note with appreciation that the Office Action recites that Applicants can request rejoinder of the Claims 17-23 once Claims 1-16 are found allowable. Applicants herewith reserve the right to request rejoinder.

### **Drawing**

The Office Action acknowledges the drawing filed on March 8, 2004 and Applicants assume that this drawing is acceptable to the USPTO.

### **Rejections Under 35 USC §102(b)**

Claims 1 to 16 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Evans, et al., U.S. Patent No. 6,342,202 ('202 patent) and Greff, et al., U.S. Patent No. 5,667,767 ('767 patent). For the following reasons, this rejection is traversed.

Initially, it is well established law that in order for a reference to anticipate a claim, the reference must disclose all of the claim elements either explicitly or inherently. As to the claim invention, it recites a composition comprising a biocompatible polymer, a biocompatible solvent and an amount of water-insoluble contrast agent (sometimes referred to herein simply as "contrast agent") ranging from greater than 40% to about 60% based on the total weight of the composition wherein the ratio of biocompatible polymer to the water-insoluble contrast agent is about 0.055 or greater.

Central to the claimed invention is the recitation of this ratio of polymer to contrast agent. As noted in the specification, the use of high concentrations of water-insoluble contrast agents is not always practical due to lack of cohesiveness of the resulting solid polymer/contrast agent mass formed *in vivo*. See, e.g., paragraphs [0014] and [0015] in the specification. Nevertheless, the use of high concentrations of contrast agent in the composition was needed to improve visibility as inconsistent visibility could result in under- or over-filling at the vascular site to be embolized. See, e.g., paragraph [0011] and Figure 1 of the specification.

This invention overcomes these problems by providing that the ratio of polymer to contrast agent must be greater than 0.055 when more than 40% water-insoluble contrast agent is employed in the composition.

Turning now to the rejection based on the '202 and the '767 patents, both of these references disclose compositions comprising a biocompatible polymer, a biocompatible solvent and from about 10 to 40 weight percent of a water-insoluble contrast agent wherein the weight percent is based on the total weight of the composition. See, e.g., Col. 3, lines 1-2, of the '202 patent and Col. 3, lines 41-43, as well as lines 42 et seq. of the '767 patent.

Regardless of whether "about 40 weight percent" reads on *greater than* 40 weight percent as per the claimed invention, there is no teaching in either of these patents of a ratio of polymer to contrast agent of greater than 0.055 *when* the contrast agent is employed in amounts greater than 40 weight percent. As such, these references fail to anticipate the claimed invention.

Withdrawal of this rejection is requested.

Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-041. Should no proper payment be enclosed herewith, as by a check or credit card payment form being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

Date 7-17-07

By Gerald F. Swiss

FOLEY & LARDNER LLP  
Customer Number: 38706  
Telephone: (650) 251-1103  
Facsimile: (650) 856-3710

Gerald F. Swiss  
Attorney for Applicant  
Registration No. 30,113